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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/896,429	06/29/2001	Gordon Scott Scholler	HO-P02234US0	8238
26271	7590	03/29/2004	EXAMINER	
FULBRIGHT & JAWORSKI, LLP 1301 MCKINNEY SUITE 5100 HOUSTON, TX 77010-3095			FARAH, AHMED M	
			ART UNIT	PAPER NUMBER
			3739	16
DATE MAILED: 03/29/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/896,429

Applicant(s)

SCHOLLER ET AL

Examiner

Ahmed M Farah

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE \_\_\_\_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 13-18 is/are allowed.
- 6) ☐ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

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## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-6 are rejected under 35 U.S.C. 102(a) as being anticipated by Dynasil Corporation's Dynasil 4000 Fused Silica.

As described and admitted by the applicant in page 12, paragraph 4 of the instant application, Dynasil Corporation provides a synthetic fused silicon dioxide lens that does not discolor or lose transmission when subjected to gamma radiation. This lens inherently features both the index of refraction and percent transmittance for the claimed wavelength as recited in the claims. To overcome this rejection, the applicant is required to provide an evidence that the Dynasil 4000 Fused Silica is not prior art to the instant application.

Claim 1 is rejected under 35 U.S.C. 102(a) as being anticipated by Edmund Scientific's Optics brochure (see Appendix A).

The Edmund optics brochure discloses various lenses made of synthetic fused silica for commercial use. Although the brochure does not teach that the lens maintains its integrity when subjected to gamma radiation, it is made from a same material as the one recited in claim 1. Hence, the Examiner's position is that this lens ' has a purity enough to resist discoloration upon prolonged

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irradiation produced by high energy irradiation sources such as UV, X-rays, gamma rays, etc., and therefore does not discolor or lose transmission when subjected to gamma radiation.' These lenses have been in the market for more than 5 years and therefore anticipate claim 1.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lai (U.S. Patent No. 5,549,632) Dynasil 4000 Fused Silica

Lai discloses ophthalmic surgery apparatus and method for determining and controlling the location of interaction point between a patient's eye and surgical laser beam, the apparatus comprising:

an interface **109** adapted to couple the patient's eye to a surgical laser **100** (see Fig. 1);

an attachment means **115** adapted to overlay the anterior surface of the eye to provide stable engagement to the eye (see Fig. 3); and

an applanation lens **111** mounted to the attachment means (see Fig. 4C), the applanation lens having an applanation surface configured to contact the eye, and therefore, applanate or flatten the anterior surface of the eye upon application of pressure.

Lai further teaches that his laser provides a laser beam suitable for ophthalmic surgery (see Claim 1, lines 4-5). However, although he describes the use of various known ophthalmic surgery lasers, which would provide the wavelength ranges of the instant claims (i.e., 275 nm - 2500 nm), he does not particularly specify the type of laser used with his invention. He further fails to teach the material in which the applanation lens is made of, or its relative transmission in the laser wavelength.

Dynasil Corporation, described above, provides a synthetic fused silicon dioxide lens that does not discolor or lose transmission when subjected to gamma radiation.

Therefore, it would have been obvious to one skilled in the art at the time of the applicant's invention to make the applanation lens from a synthetic fused silica or material that transmits UV light, and withstands prolonged high-energy irradiation such as UV, X-rays, or gamma radiation as presently claimed, in order to avoid discoloration/degradation that may be subjected to the lens. The use of such lens would maintain/prolong the integrity of the lens, and therefore would be cost effective. It would further eliminate the time needed to re-align a surgical system with an ordinary glass lens in the case the lens is damaged and its focusing properties changed. Furthermore, the use of UV-grade lenses to transmit the maximum intensity/energy of an irradiated UV light is well known in the art.

#### ***Allowable Subject Matter***

Claims 13-17 are allowed. The prior art of record fails to disclose, teach or suggest a method for ablating on the anterior surface of a patient's eye and coupling the eye to a surgical laser as claimed, wherein the method comprises

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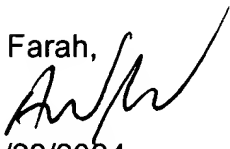
the step of providing an interface that has been sterilized with gamma radiation,  
the interface including a central orifice, and an applanation lens.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ahmed M Farah whose telephone number is (703) 305-5787. The examiner can normally be reached on Mon-Fri. 9:30 AM – 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M DVorak can be reached on (703) 308-0994. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A. Farah,

  
03/22/2004